

have nonetheless amended the specification as set forth above to define the abbreviation IDGM. This change does not introduce any new matter into the specification. The abbreviation STB is defined on page 25 at line 21 as meaning “set top box”.

Claims 1 through 30 are pending in the instant application. The Examiner rejected Claim 1 under 35 U.S.C. §112, second paragraph, as being indefinite. The Examiner stated that “It is not understood from the claim language in the steps that follow what is being done with the collected data.” As set forth above, Applicants have amended Claim 1 for clarity.

The Examiner also rejected Claim 1 under 35 U.S.C. §112, second paragraph, because “...it is not understood what Applicants’ mean by ‘deriving at least one user model for said at least one set top boxes’” (Office Action page 3, line 1). The term user model is discussed in the specification at, for example, paragraph 365, and may be, for example, the age, sex, race, income, and education level of one or more STB users, although additional fields may be added to the user model, or fields may be removed from the table, to improve the accuracy of the user model. The term “user model” is also used throughout the specification after paragraph 365. The Court of Appeals for the Federal Circuit has consistently held that an applicant can be his or her own lexicographer, provided a definition is contained in the specification. *See, e.g., In re Thrift*, 298 F.3d 1357, 1364 (Fed. Cir. 2002); *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 980 (Fed. Cir. 1995) (*en banc*), *aff’d*, 517 U.S. 370. Applicants feel that the term is sufficiently well defined to meet the requirements under 35 U.S.C. §112, second paragraph.

Claims 1-3, 13-19, and 23 were rejected under 35 U.S.C. §102(e) as being anticipated by Salganicoff. In making this rejection, the Examiner cites column 3, lines 4-12 of the Salganicoff patent as teaching the first element of Claim 1 of Applicants’ invention. Column 3, lines 4-12 of the Salganicoff patent teaches that problems existing in customized programming delivery systems can be overcome “by creating customized programming channels from all of the programming available at any time and broadcasting the customized programming channels to groups of customers. The customer’s set top multimedia terminal then creates ‘virtual channels’ as a collection of the received programming data from one or more of the customized programming channels at any point in time for receipt on the customer’s television.” The first element of Applicants’ Claim 1

claims collecting data associated with at least one set top box. The portion of the Salganicoff patent cited by the Examiner does not teach or suggest the collection of data associated with at least one set top box, but rather the creation of “virtual channels” based on programming available from broadcasters at any given time.

The Examiner also rejects Claims 1-3, 13-19, and 23 under 35 U.S.C. §102(e) as being anticipated by Salganicoff because, in the Examiner’s opinion, column 3, lines 15-19 teach the second element of Claim 1 of Applicants’ invention. Column 3, lines 15-19 of the Salganicoff patent teaches that, as used within the Salganicoff patent, the term “virtual channel” is “a channel formed as a composite of several source materials or programs which may or may not change during respective time periods to reflect the programming most desirable to the customer during that period. The creation of such ‘virtual channels’ is intended to minimize the amount of ‘channel surfing’ necessary to find the most preferred video program at a particular time.” Column 3, lines 15-19. The second element of Applicants’ Claim 1 claims deriving at least one user model for each of the set top boxes based on the data collected from the set top boxes. The portion of the Salganicoff patent cited by the Examiner does not teach the derivation of a user model based on data collected from a set top box, but rather teaches the creation of a virtual channel which contains programming most desirable to the customer based on programming broadcast at a given time.

The Examiner also cites column 9, lines 34-55, as teaching the third element of Applicants’ Claim 1. Column 9, lines 34-55 teaches how the techniques of the Salganicoff patent “are used for creating content profiles which characterize the data sources in accordance with their degree of content of predetermined characteristics.” The third element of Applicants’ Claim 1 claims storing at least one derived user model and an identifier corresponding to the set top box from which the at least one user model is derived in a storage means for later retrieval. The portion of the Salganicoff patent cited by the examiner does not teach storing derived user models and set top box identifiers, but rather teaches characterizing content according to predetermined characteristics.

The sections of the Salganicoff patent cited by the Examiner clearly do not disclose all of the elements of Applicant’s invention as claimed in Claim 1. The Court of Appeals for the Federal Circuit has consistently held that “Anticipation requires the presence in a

single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.” Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick, 221 USPQ 481, 485 (Fed. Cir. 1984). The Salganicoff patent clearly fails to disclose structure positively recited and claimed in applicant's independent claims, and therefore Applicants’ claims are patentable over the Salganicoff patent.

In addition, the Salganicoff patent as a whole does not teach Applicants’ claimed invention. The Salganicoff patent describes the creation of a customer profile based on demographic or other individual-specific information known about the customer. The Salganicoff patent also teaches that customer profiles can be maintained by comparing the television show watched by the customer to the television show the customer was predicted to watch based on the shows available to the customer at any given time. Inherent in this model is the knowledge of the customer’s identity at all times, as is evidenced by the Salganicoff patent’s continual reference to the customer’s actions.

Applicants’ claimed invention, on the other hand, includes the collection of data associated with at least one set top box, from which at least one user model is derived for each set top box. Unlike the Salganicoff patent, Applicants’ invention does not rely on individual-specific data in the creation and maintenance of the user models. The Salganicoff patent clearly does not disclose all of the elements of Applicant’s invention as claimed in Claim 1. Thus, the Salganicoff patent clearly fails to disclose structure positively recited and claimed in applicant's independent claims, and therefore Applicants’ claims are patentable over the Salganicoff patent.

Claims 2 through 12 are dependent upon Claim 1 and are therefore patentable for all of the reasons set forth above.

With respect to Claim 13, the Examiner rejected this claim under 35 U.S.C. §102(e) as being anticipated by Salganicoff. The Examiner begins by citing column 43, lines 17-65 of the Salganicoff patent as anticipating the first element of Applicants’ Claim 13. Column 43, lines 17-65 teaches the use of RSA encryption for a “...secure transmission path for transmitting preference data, profile data and the like from the set top multimedia terminal to the head end...”. Column 43, lines 66-67, and column 44, lines 1-2. As defined in Applicants’ specification, the term “privacy compliant” is used to define a process through which data is gathered about one or more individuals, such as an

individual's interaction with a set top box, without knowing any information about the individual. For example, as taught in the Applicants' present patent application, only the zip code in which the set top box resides is known. See, e.g., paragraphs 24-26. The cited section of the Salganicoff patent clearly does not disclose such a data collection technique.

The Examiner next cites column 2, lines 60-67, and column 3, lines 1-3 of the Salganicoff patent as anticipating the second element of Applicants' Claim 13. The cited section of the Salganicoff patent teaches that a customer indicates his or her programming preferences by changing channels, that such channel changes are monitored by Nielson, Arbitron, and other ratings agencies, and that in U.S. Patent No. 5,155, 591, one of the Salganicoff patent inventors described a process through which information is obtained about the customer and then television commercials are targeted to the customers most likely to respond favorably to such advertising. The second element of Applicants' Claim 13 recites deriving at least one user model for each set top box from data collected in a privacy compliant manner using an inverse demographic matrix method. The cited portion of the Salganicoff patent does not teach the use of an inverse demographic matrix to derive user models.

The sections of the Salganicoff patent cited by the Examiner clearly do not disclose all of the elements of Applicant's invention as claimed in Claim 13. The Court of Appeals for the Federal Circuit has consistently held that "Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick, 221 USPQ 481, 485 (Fed. Cir. 1984). The Salganicoff patent clearly fails to disclose structure positively recited and claimed in applicant's independent claims, and therefore Applicants' claims are patentable over the Salganicoff patent.

Claims 14 and 15 are dependent upon Claim 13 and are therefore patentable for the reasons set forth above with respect to Claim 13.

The Examiner rejected Claims 4-12, 20-22, and 24-30 under 35 U.S.C. §103(a) as being unpatentable over Salganicoff in view of U.S. Patent No. 6,285,983 B1 to Jenkins ("the Jenkins patent"). Claims 4-12 are dependant upon Claim 1, Claims 20-22 are dependant upon Claim 19, and Claims 24-26 depend upon Claim 23; these claims are patentable for the reasons set forth above.

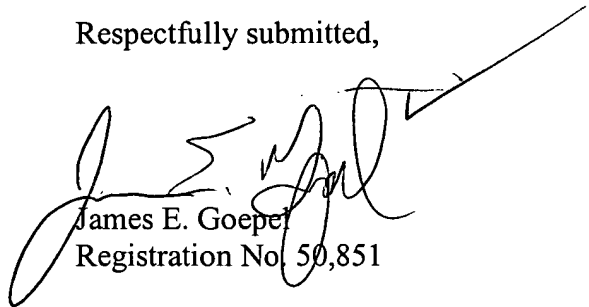
Further, no motivation to combine the Jenkins and Salganicoff patent with any other prior art to suggest Applicant's claimed invention has been shown. While the Examiner makes an unsupported statement that such combination would have been obvious "...because such a modification would allow Salganicoff's system to have sophisticated direct-to-consumer marketing initiatives in a range of industries while preserving consumer privacy", there is nothing in the prior art to suggest such motivation. Citing references which merely indicate that isolated elements and/or features recited in the claims are known is not a sufficient basis for concluding that the combination of claimed elements would have been obvious. Ex parte Hiyamizu 10 USPQ2d 1393 (BPAI 1988). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In re Geiger 815 F.2d 686 (Fed. Cir. 1987), 2 USPQ2d 1276; In re Fine 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Furthermore, the Examiner's combination of the Salganicoff and Jenkins patents is believed to be motivated by hindsight, rather than by a teaching or suggestion within the prior art. As stated by the Court of Appeals for the Federal Circuit, "'Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention.' ATD Corp. v. Lydall, Inc., 159 F.3d 534, 546 (Fed. Cir. 1998). There must be a teaching or suggestion within the prior art, within the nature of the problem to be solved, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources, to select particular elements, and to combine them as combined by the inventor. See, Ruiz v. A.B. Chance Co., 234 F.3d 654, 665, (Fed. Cir. 2000); ATD Corp., 159 F.3d at 546; Heidelberger Druckmaschinen AG v. Hantscho Commercial Prods., Inc., 21 F.3d 1068, 1072 (Fed. Cir. 1994) ('When the patented invention is made by combining known components to achieve a new system, the prior art must provide a suggestion or motivation to make such a combination.')." Crown Operations Intern., Ltd. v. Solutia Inc., 289 F.3d 1367, 1376 (Fed. Cir. 2002).

In light of the arguments outlined above, Applicants believe Claims 1-30 to be in condition for allowance, and Applicants therefore respectfully request such a determination from the Examiner. Should the Examiner feel that there are any issues outstanding after

consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution. You are hereby authorized to charge or credit any deficiency or overpayment associated with the filing of this response to our Deposit Account No. 50-0653.

Respectfully submitted,



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